

REMARKS

This Amendment is filed in response to the Office Action dated December 28, 2007, along with a Petition to Revive under 37 C.F.R. §1.137(b) filed on even date herewith. All rejections and objections are respectfully traversed.

Claims 1 – 20 are pending in this case.

Claims 1, 4, and 8 have been amended to better claim the invention.

Request for Examiner Interview

The Applicant respectfully requests a telephonic interview with the Examiner after the Examiner has had an opportunity to consider this Amendment, but before issuance of the next Office Action. The Applicant's undersigned attorney may be reached at 617-951-2500.

Double Patenting

At paragraphs 34 and 35 of the Office Action, claims 1 – 20 were provisionally rejected on the ground of nonstatutory double patenting over claims 1 – 3, 5 – 8, 11, and 13 – 20 of co-pending Application No. 10/608,651 and over claims 1 – 4, 6, 8, 11 – 14, and 16 – 26 of co-pending Application 10/608,664. Applicant respectfully submits that the terminal disclaimer filed herewith satisfies the rejection.

35 U.S.C. §112, Second Paragraph

At paragraphs 3 – 6 of the Office Action, claims 1 and 4 were rejected under 35 U.S.C. §112, second paragraph. With respect to claim 1, the Examiner asserted there is insufficient antecedent basis for “the limitations ‘reporting the status of the financial service project’ and ‘information concerning the ultimate client’”. (See Office Action paragraph 5). Further, the Examiner asserts that the limitation ‘the outsourced personnel preparing the tax returns through a remote limited access client located outside the first and second countries connected to the host server’ does not clearly disclose a component of a method claim. Applicant respectfully submits that the amended claim 1 satisfies the requirements of 35 U.S.C. §112, Second Paragraph.

Moreover, with respect to claim 4, the Examiner asserted that there is insufficient antecedent basis for the limitation ‘comprising the intermediary service firm’. (See Office Action, paragraph 6). Applicant respectfully submits that amended claim 4 satisfies the requirements of 35 U.S.C. §112, Second Paragraph.

Claim Rejections - 35 U.S.C. §103

At paragraphs 7 – 33 of the Office Action, claims 1 – 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baker, U.S. Patent No. 6,473,741 in view of Dang et al., U.S. Publication No. 2003/0101111.

The Applicant’s claim 1, representative in part of the other rejected claims, sets forth (emphasis added):

1. A financial services outsourcing method for facilitating outsourcing of tax return preparation services for numerous clients on behalf of plural direct service providers serving the numerous clients, the financial services being outsourced to a given outsourcing group, the clients comprising a first set of clients in a first country, having tax return filing obligations for the first country, and comprising a second set of clients in a second country having tax return filing obligations for the second country, the method comprising:

for plural respective direct service providers, loading, onto a remotely accessible part of a common host server, client specific financial files and corresponding reference materials, the host server providing access to a remote computer client of information concerning the client specific financial files and corresponding reference materials;

preparing tax returns for the clients of the direct service providers by outsourced personnel, the outsourced personnel located outside the first and second countries;

providing the outsourced personnel limited access to the server;
the outsourced personnel preparing the tax returns through a remote limited access client located outside the first and second countries connected to the host server; and,

monitoring and reporting a status of the tax returns preparation.

By way of background, Baker discloses a system and method for the electronic exchange of tax data between those in the financial service industry. (See Baker, col. 5, lines 34 – 39). Specifically, tax preparation firms submit their databases of income tax data for archival and later retrieval by requesting organizations (“**as a result of auto-**

mated tax preparation, these accounting and tax firms have warehouses of databases of tax returns in digitized format.” See Baker, col. 8, lines 46 – 49). A service bureau then organizes the data from the different firms and coordinates dissemination of the data for a rental fee or user fee to third parties. (See Baker, col. 8, lines 65 – 67). Third parties then retrieve the data for the fee and utilize the data to obtain patterns and relationships that are otherwise not readily evident. (See Baker, col. 2, lines 46 – 51).

By way of further background, Dang provides a technique related to identifying and monitoring taxable transactions, and calculating taxes due on a transaction. (See Dang, paragraph [0008]). Domestic businesses are usually required by state and local authorities to charge sales and/or use tax for most commercial (i.e., sales of goods) transactions relating to goods. (See Dang, paragraph [0002]). Therefore, Dang provides a system that enables merchants to electronically outsource the burden of tax calculation and remittance to state-certified service providers. (See Dang, paragraph [0035]). Specifically, the Dang system collects data based on a financial transaction, calculates any taxes due on the transaction, reports the information to a selected government authority, and periodically remits funds corresponding to the tax owed to the government authority. (See Dang, paragraph [0018]).

Applicant respectfully urges that Baker and Dang, either alone or in combination, fail to teach or suggest Applicant’s claimed novel *preparing tax returns for the clients of the direct service providers by outsourced personnel, the outsourced personnel located outside the first and second countries ... the outsourced personnel preparing the tax returns through a remote limited access client located outside the first and second countries connected to the host server; and monitoring and reporting a status of the tax returns preparation*.

In short, Applicant claims a system and method for outsourcing tax return preparation services, while Baker discloses a system that transmits already completed tax information to third parties and Dang discloses a system that computes sales tax for merchants.

Applicant claims a system and method for outsourcing tax return preparation services. In Applicant’s system, client specific financial files and corresponding reference

materials are loaded on a host server. For example, the financial file may include “the last season tax return as filed, receipts and summary information regarding finances, a W-2 form, 1099 forms,” etc... (See Applicant’s Specification, page 3, 2nd full paragraph). Using this information, the outsource personnel can prepare the tax returns on behalf of the direct service providers.

Quite different from Applicant’s claim as highlighted above, Baker merely provides tax information (i.e., already completed tax information) to third parties that utilizes the information to obtain patterns and trends (i.e., data mining). This is clearly disclosed at col. 8, lines 46 – 67 of Baker that states,

As a result of automated tax preparation, these accounting and tax firms have warehouses of databases of tax returns in digitized format...As a result of owning these data bases of taxpayer data that originate from the performance of professional accounting and tax preparation services, these data now have value if they can be organized and coordinated to capitalize on the data...a service bureau can organize all these data and coordinate dissemination of such data for a rental fee or user fee.

Therefore, the information that is provided to the service bureau is already completed tax data that is utilized for data mining. There is no disclosure in Baker of preparing tax returns as is claimed by Applicant. Therefore, Applicant respectfully submits that Baker fails to teach or suggest Applicant’s novel claim as highlighted above.

Further, Dang also fails to teach Applicant’s novel claim. Specifically, Dang merely discloses a system that enables merchants to electronically outsource the burden of computing sales tax on a transaction. (See Dang, paragraph [0008]). Specifically, Dang system collects data based on a financial transaction, calculates any taxes due on the transaction, reports the information to a selected government authority, and periodically remits funds corresponding to the tax owed to the government authority. (See Dang, paragraph [0018]). The Dang publication is completely silent with respect to preparing the tax returns as is claimed by Applicant.

Accordingly, Applicant respectfully submits that Baker and Dang, either alone or in any combination, are legally insufficient to render the present claims unpatentable under 35 U.S.C. §103 because of the absence in Baker and Dang of Applicant’s claimed

novel preparing tax returns for the clients of the direct service providers by outsourced personnel, the outsourced personnel located outside the first and second countries... the outsourced personnel preparing the tax returns through a remote limited access client located outside the first and second countries connected to the host server; and monitoring and reporting a status of the tax returns preparation.

Conclusion

All independent claims are believed to be in condition for allowance.

All dependent claims are dependent from independent claims which are believed to be in condition for allowance.

Accordingly, all dependent claims are believed to be in condition for allowance.

Please charge any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,

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